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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/631,955

07/30/2003

Ognian Z. Topalov

AOL0121

1777

22862 7590 10/19/2009
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EXAMINER

LUDWIG, MATTHEW J

ART UNIT

PAPER NUMBER

2178

NOTIFICATION DATE

DELIVERY MODE

10/19/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

eptomatters@glenn-law.com

Office Action Summary	Application No. 10/631,955	Applicant(s) TOPALOV ET AL.	
	Examiner MATTHEW J. LUDWIG	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 7-12 and 20-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 13-19 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/14/08, 7/30/03</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to the application filed 7/30/03. Applicant's election without traverse of Group 1, in the reply on 7/10/09 is acknowledged.
2. Claims 2-6, 13-19, and 26 are pending in the application. Claims 2, 5, 6, 13, 14, 15, 18, 19, and 26 are independent claims.
3. Applicant elected without traverse, Group I, claims 2-6, 13-19, 21, and 26, to be examined. Dependent claim 21 should have been included within Group II, due to the fact it is a dependent claim dependent on independent claim 20. Applicant should amend dependent claim 21 as withdrawn in further amendments.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. **Claims 2-4, 14, 18, 19 and 26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Data structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. *See, e.g., In re Warmerdam*, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and

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functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Similarly, computer programs claimed as computer listings *per se*, *i.e.*, the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. *See In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035.

Claims 2-4, 14, 18, 19, and 26 set forth an apparatus which include usable program code for carrying out form filling. The apparatus claims comprise a series of series of steps that can be reasonably interpreted in view of the specification as software, *per se*. The claim does not define any structural and functional interrelationships between the software elements and a computer that would permit the described functionality to be realized when the software is employed as a computer component. The absence of any hardware found within the limitations of the claims fails to define patentable subject matter and fails to fall within any of the categories of patentable subject matter set forth in 35 U.S.C. § 101, and such claims are therefore ineligible for patent protection. *See* 1300 OG 142 (November 22, 2005) (in particular, see Annex IV(c)).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **In reference to independent claims 13 and 26**, the claims recite the limitation

"transformation format" in the claim. There is insufficient antecedent basis for this limitation in the claim. Further, it is unclear whether the phrase 'formatting said data' is referring back to user data, field data, or all data. The vexatious nature of the language found within the claims preclude the examiner from assembling a clear idea of the claim when read as a whole.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. **Claims 2-6, 13-19, and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Kablesh et al., US PGPub. 2006/0100754 filed 4/21/2006.**

In reference to independent claim 2 and 15, Kablesh teaches:

‘a form fill engine for analyzing a context of users' navigation, and completing a form upon user's consent or user initiated actions, wherein said form fill engine pulls user data and rules to map said data to a requested form'

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The reference provides a form entry program which keeps track of user's selections and based upon user initiated actions, the form system pulls user data and rules to map content into specific fields. See page 4, [0041-0049].

‘a reverse mapping engine for implementing a reverse mapping algorithm, wherein after said form fill engine recognizes a match, extracted knowledge from said match is communicated to a reverse mapping server for storage into a reverse mapping database’

The reference discloses a form entry program may retrieve information from data storage for fields that the form system has previously encountered from other electronic forms for user or through data imports into the form system.

‘wherein a resulting profile is used to help all subsequent users to fill the same form’

The administrative management program provides a data management to help users fill the same form by exporting data/forms to specific recipients. See page 6, [0058-0061].

In reference to dependent claim 3 and 16, Kablesh teaches:

Administrative data management program enables data recipients to share information with a form system. An information delivery program is used by data recipients who have management information systems and want to share electronic information. The shared information may include, for example, one or more electronic forms and/or information from one or more of the electronic forms. Data recipients may supply to form system information about users. See page 6, [0057 - 0059].

In reference to dependent claim 4, 5, 17, and 18, Kablesh teaches:

‘for every form a user submits, collecting field names and corresponding values said user has entered;

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comparing values with a same user's data found in a central subscription subscription service database;

if a match between submitted data and said user's profile is found, considering this as a hit and, after that, marking a name of a hit field according to a type of said user's data that matches;

repeating the above steps until a statistically reliable confidence level about a real meaning of said fields is reached; and

thereafter, migrating said form to a mapped status;

wherein all subsequent users using said same form thereafter receive service based on a profile built by learning from an set of users.'

The reference to Kablesh provides a means of submitting forms and collecting field names/values user has entered. When a user selects electronic forms from the form system the form entry program may retrieve from data storage information for fields from the form system previously encountered from other electronic forms. It provides this service through specific matches or hits. The reference provides an example of mapping content to forms and overriding default values. This step of overriding values for a checkbox would provide a statistically reliable confidence level (as presently claimed) about a real meaning of said field. The form would then be in a mapped status based upon a reverse mapping method. The last limitation of the claim is unclear and provides no explanation of what type of profile is built and what is learned from an initial set of users. The administration data management program enables data recipients to share information with a form system, thus making it easier to learn from a ser of

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users based upon content supplied to the form system. See page 4, [0044 - 0048], page 5, 0054 - 0055], and page 6, 0056 - 0059].

In reference to independent claim 6 and 19, Kablesh teaches:

User may supply family information or change/update existing family information. Form entry program keeps track of user's selections. An auto fill data program detects and handles any collisions in snapping data into electronic forms. See page 4, [0047 – 0048] and page 5, [0049 - 0052].

In reference to independent claim 13, 14 and 26, Kablesh teaches:

A form entry program may retrieve from data storage information for fields that the form system has previously encountered from other electronic forms for user or through data imports into the form system. See page 4, [0047 – 0048].

The administrative management program provides a data management to help users fill the same form by exporting data/forms to specific recipients. See page 6, [0058-0061]. The resulting profile, as presently claimed, is not described within the claim and therefore is be interpreted as data stored through administrative data management program and shared by data recipients to help subsequent users fill out a same form.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW J. LUDWIG whose telephone number is (571)272-4127. The examiner can normally be reached on 9:00am-6:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Stephen S. Hong/
Supervisory Patent Examiner, Art Unit
2178

ML